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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,450	12/14/2001	Norman Muttitt	00229.0028.NPUS00	1079
22930	7590	02/25/2005	EXAMINER	
HOWREY SIMON ARNOLD & WHITE LLP c/o IP DOCKETING DEPARTMENT 2941 FAIRVIEW PARK DR, SUITE 200 FALLS CHURCH, VA 22042-2924			NASH, LASHANYA RENEE	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/014,450	MUTTITT	
	Examiner	Art Unit	
	LaShanya R Nash	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 December 2001.  
 2a) This action is **FINAL**.                                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date April 15, 2002.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

Claims 1-24 are being considered.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on April 15, 2002 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2,7-8,13-14, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett et al. (US Patent Application Publication 2001/0032137), hereinafter referred to as Bennett.**

In reference to claim 1, Bennett discloses a method for distribution of targeted and highly personalized emails (abstract), which comprises:

- A method for providing different combinations of multiple pieces of content in a single e-mail to a plurality of patrons, (abstract and paragraph [0008], line 1 to paragraph [0009], line 21), the method comprising:
  - Maintaining a database identifying each of the patrons and each patron's corresponding interest, (paragraph [0034], line 1 to paragraph [0036], lines 25 and paragraph [0042], lines 1-17);
  - Matching the multiple pieces of content to each of the patrons based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9);
  - Generating the single e-mail for each of the patrons, wherein the e-mail contains the multiple pieces of content; and delivering the e-mail to each of the patrons, (paragraph [0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 7, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for providing different combinations of multiple pieces of content in a single e-mail to a plurality of patrons (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 1), the system comprising:
  - Means for (Figure 1-item 24) maintaining a database (Figure 1-item 23) identifying each of the patrons and each patron's corresponding

interest, (paragraph [0012], lines 1-11; paragraph [0036], lines 1-25; and paragraph [0042], lines 1-17);

- Means for (Figure 1-item 24) matching the multiple pieces of content to each of the patrons based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730, line 1 to paragraph [0074], line 17);
- Means for (Figure 1-item 24) generating the single e-mail (Figure 1-item 27) for each of the patrons, wherein the e-mail contains the multiple pieces of content; and means for delivering the e-mail to each of the patrons, (paragraph [0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 13, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for providing multiple pieces of content in a single e-mail (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 1), the system comprising:
- A plurality of patrons, (Figure 1-item 26);
- A and a processor (Figure 1-item 24) programmed to:
  - Maintain a database (Figure 1-item 23) identifying each of the patrons and each patron's corresponding interest, (paragraph [0066], line 1 to

paragraph [0069], line 9; and paragraph [00730, line 1 to paragraph [0074], line 17);

- Match the multiple pieces of content to each of the patrons based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730, line 1 to paragraph [0074], line 17);
- Generate the single e-mail (Figure 1-item 27) for each of the patrons, wherein the e-mail contains the multiple pieces of content; and deliver the e-mail to each of the patrons, (paragraph [0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 19, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for providing multiple pieces of content in a single e-mail (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 10), the system comprising:
- A content management subsystem (i.e. Figure 10 items 23 and 232; main database and ready contact), wherein the content management subsystem is adapted to receive content as input and is adapted to deploy the content into a first database, (paragraph [0091], lines 1-9);

- A datamart subsystem (i.e. Figure 10-item 244; campaign filter), wherein the datamart subsystem is adapted to extract content from the first database (Figure 10-item 23) and one or more other databases (Figure 10-item 238 and 240) and is adapted to match a plurality of patrons to a single piece of content, based on each patron's corresponding interest, (paragraph [0091], lines 9-16);
- A targeted e-mail application subsystem (i.e. Figure 10-item 244; campaign filter), wherein the targeted e-mail application subsystem is adapted to merge each single piece of content matched to each of the plurality of patrons, so as to provide a single e-mail having multiple pieces of content for each of the plurality of patrons, (paragraph [0091], lines 9-16); and
- An e-mail vendor subsystem (Figure 10-item 230; e-mail send queue), wherein the e-mail vendor subsystem is adapted to distribute the targeted e-mail to each of the plurality of patrons, (paragraph [0091], lines 16-35).

In reference to claims 2,8,14, and 20 Bennett shows the target e-mail method and system further comprising prioritizing the multiple pieces of content for placement in the e-mail, (paragraph [0091], lines 27-35).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 3-4, 9-10, 15-16 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied to claims 1,7,13, and 19 above, in view of Mindrum (US Patent 4,723,212), hereinafter referred to as Mindrum.**

In reference to claims 3,9,15, and 21 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising limiting the number of pieces of content to be provided in the e-mail. However, this limitation was well known in the art at the time of the invention, as further evidenced by Mindrum. Therefore it would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett.

In an analogous art, Mindrum discloses a method for electronically dispensing merchant provided content (i.e. coupon), wherein the number of coupons per transaction is limited, (abstract). One of ordinary skill in the art would have been so motivated to implement this modification so as to raise the potential for creating new customers, and thereby increasing system effectiveness for merchants, (Mindrum column 1, lines 60-65).

In reference to claims 4,10,16, and 22 Bennett shows the target e-mail method and system, further comprising eliminating duplicate pieces of content, (paragraph [0042], lines 1-13).

**Claims 5,11,17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied to claims 1,7,13, and 19 above, in view of Kamakura (US Patent 6076101), hereinafter referred to as Kamakura.**

In reference to claims 5,11, and 23 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising sorting the multiple pieces of content into defined categories. However, this limitation would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett, as further evidenced by Kamakura.

In an analogous art, Kamakura discloses an electronic mail processing method and system that generates consumer-interest based target emails, wherein the email content is organized into defined categories, (column 4, lines 37-51). One of ordinary skill in the art would have been so motivated to implement this modification so as to improve the organizational arrangement of targeted email content, and thereby increasing system ease of use for consumers/email recipients, (Kamakura column 1, lines 57-60).

**Claims 6,12,18, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Kamakura (US Patent 6076101), hereinafter referred to as Kamakura, and further in view of Mindrum.**

In reference to claims 6,12, and 24 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising sorting the multiple pieces of content into defined categories. However, this limitation would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett, as further evidenced by Kamakura.

In an analogous art, Kamakura discloses an electronic mail processing method and system that generates consumer-interest based target emails, wherein the email content is organized into defined categories, (column 4, lines 37-51). One of ordinary skill in the art would have been so motivated to implement this modification so as to improve the organizational arrangement of targeted email content, and thereby increasing system ease of use for consumers/email recipients, (Kamakura column 1, lines 57-60). Bennett and Kamakura fail to show limiting number of pieces of content within the e-mail categories. However, this limitation was well known in the art at the time of the invention, as further evidenced by Mindrum. Therefore it would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett and Kamakura.

In another analogous art, Mindrum discloses a method for electronically dispensing merchant provided content (i.e. coupon), wherein the number of coupons per transaction is limited, (abstract). One of ordinary skill in the art would have been so motivated to implement this modification so as to raise the potential for creating new

customers, and thereby increasing system effectiveness for merchants, (Mindrum column 1, lines 60-65).

### ***Conclusion***

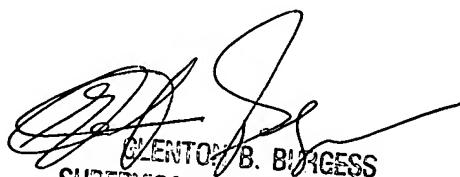
Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit, 2153  
February 18, 2005

*JM*



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